

REMARKS

Reconsideration and allowance of this application are respectfully requested in light of the foregoing amendments and the following remarks.

Claim Status

Claims 1 - 14 as presented in the originally filed application are still active in this case. The Examiner requested a restriction to claims 1-9 in this matter, claims 8, 10-14 have been withdrawn.

Accordingly, claims 1-7 and 9 are pending in the application. Claims 1, 4, 6 and 9 are amended.

Election

The Examiner had divided this case into two distinct groups, Group I, claims 1-9, drawn to a battery separator, which are now pending and Group II, claims 10-14, drawn to a thermoplastic polymer formation, withdrawn. Applicant affirms the election of Group I in this case. Applicant reserves the right to file one or more divisional applications drawn to the non-elected subject matter of the withdrawn claims of Group II.

Claim Objections

Claims 4 & 9 stand objected to because they recite improper group language. Applicant has amended claims 4 & 9 as suggested by the Examiner and respectfully requests that the objection to these claims be removed and the claims allowed.

§112 Rejection

Claims 6-9 stand objected to under 35 USC § 112, second paragraph. Applicants have amended claim 6 to overcome the rejection and respectfully request allowance of claims 6, 7 and 9.

§102 Rejection

Claims 1-9 stand objected to under 35 USC § 102(b), as being anticipated by Navarrete et al., WO 02/28955 A2. Applicant traverses this rejection. MPEP 2131 clearly states that "to anticipate a claim, the reference must teach every element of the claim." This is not the case here. What differentiates the cited reference from Navarrete et al., WO 02/28955 A2, is the use of grass lignins. Navarrete et al., WO 02/28955 A2, clearly defines lignins on page 8 which states:

Lignin refers to those by-products of wood pulping operations having extremely complex chemical structures that consist primarily

of phenyl propane linked together in three dimensions. Lignins include softwood lignins, hardwood lignins, and mixtures thereof. Hardwood lignins are preferred.

Lignins as used in the abstract and claims of Navarrete et al., WO 02/28955 A2, clearly defines lignins as softwood lignins, hardwood lignins and mixtures thereof, it does not include grass lignins. The Examiners avers that grass lignins are disclosed on page 1, this is true, but the only mention is that grass lignins exist, there is no teaching or suggestion to use grass lignins in a battery separator. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). In the detailed description lignins are defined as softwood lignins, hardwood lignins and mixtures thereof. The identical invention is not present because Navarrete et al., WO 02/28955 teaches use of hardwood and softwood lignins and not grass lignins.

The suggestion by the Examiner that grass lignins are anticipated is incorrect, it is not even obvious, it is at very best, merely obvious to try. In moving from the prior art to the claimed invention, one cannot base a determination of obviousness on what the skilled person might try or find obvious to try. Rather, the proper test requires determining what the prior art would have led the skilled person to do.

In *Dow Chemical*, the claims covered a polymer suitable for molding and extrusion. The polymer contained three components, which for discussion purposes, included styrene, maleic anhydride, and synthetic diene rubbers. The board relied on two prior art references in holding the claimed polymer *prima facie* obvious: The first reference disclosed a polymeric resin composed of diene rubber and styrene, and the second reference taught a technique for preparing maleic anhydride-styrene copolymers. The board held that one skilled in the art *might* have obtained the claimed polymer by applying the technique of the second reference to a styrene-maleic anhydride polymer system that included some synthetic diene rubber. In fact, the board admitted that "[i]t is not apparent from the evidence whether rubber and maleic anhydride would have been expected to react *in the process suggested by the combined disclosure of [the cited references].*" 837 F.2d at 471, 5 U.S.P.Q.2d at 1530 (emphasis in original).

In evaluating obviousness, the court made it very clear that one must look to see if "the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art." *Id.* at 473, 5 U.S.P.Q.2d at 1531. "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.*

Against this backdrop, the Federal Circuit held that the board's proposed combination of the art to support its decision on obviousness, "presents, in essence, an 'obvious to experiment' standard for obviousness." *Id.* at 473, 5 U.S.P.Q.2d at 1532. The court further stated that the prior art must provide some reason or

suggestion for selecting the board's proposed procedure, yet nothing the board has cited "suggests that any process could be used successfully in this three-component system, to produce [the claimed product] having the desired properties." *Id.* Viewing the evidence as a whole, the Federal Circuit held that it did not support the board's conclusion of obviousness and reversed that conclusion. *Id.*

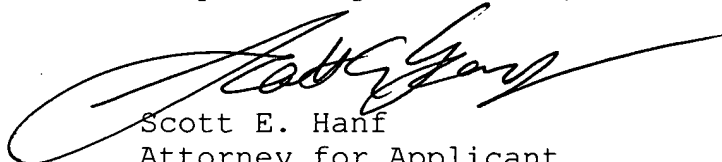
In *In re Tomlinson*, 363 F.2d 928, 150 U.S.P.Q. 623 (C.C.P.A. 1966), the CCPA considered the patentability of an invention directed to polypropylene stabilized with a particular class of dithiocarbamates. The prior art disclosed polyethylene stabilized with these dithiocarbamate compounds. Because of the close structural similarity between polypropylene and polyethylene, the PTO concluded that a skilled chemist would have found it obvious to try to stabilize polypropylene with a known stabilizer for polyethylene.

The court responded to the PTO's position on this matter by noting that "there is usually an element of 'obviousness to try' in any research endeavor, that it is not undertaken with complete blindness but rather with some semblance of a chance of success." *Id.* at 931, 150 U.S.P.Q. at 626. Permitting patentability determinations based on an "obvious to try" test "would not only be contrary to statute but result in a marked deterioration of the entire patent system as an incentive to invest in those efforts and attempts which go by the name of 'research.'" *Id.*

Conclusion

In view of the foregoing, Applicant respectfully requests an early Notice of Allowance in this application.

Respectfully submitted,



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